

REMARKS

I. STATUS OF THE CLAIMS

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration because they are directed to nonelected subject matter. No claim amendments have been made.

Applicants again remind the Examiner of the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121 to expand the search to the non-elected species once the elected species are found to be allowable.

II. REJECTIONS OVER LEE

The Examiner has maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 102(b) over EP 0 551 749 (*Lee*). The Examiner has also rejected claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 103(a) over *Lee*. In these two rejections, the Examiner relies on the principle that "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." Final Office Action at page 3. The Examiner further stated that "the disclosed examples and preferred embodiments in the reference do not constitute a teaching which is away from a broader disclosure or nonpreferred embodiments." *Id.* Applicants respectfully disagree for the reasons set forth below.

As an initial matter, Applicants note that the Examiner argues that "applicants' characterization of *Lee*'s teachings is incomplete." Final Office Action at pages 2 and 3. Applicants respectfully point out that the characterization questioned by the Examiner

was not Applicants', but rather the Examiner's, and was made in the Examiner's first Office Action dated May 22, 2001. See page 4 of the Office Action.

A. Rejection under 35 U.S.C. § 102(b)

A rejection under § 102 is only proper when the "claimed subject matter is identically described or disclosed in the prior art." *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). M.P.E.P. 706.02(a) also states that "[f]or anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."

In the present case, the Examiner argues that the disclosed examples and preferred embodiments are no longer being relied upon in the rejection; rather, the broader disclosure of *Lee* is now being relied upon. See final Office Action at page 3. By no longer relying on the preferred embodiment, selection is therefore now necessary in an attempt to arrive at the claimed invention. In order to identically describe or disclose the claimed composition, however, "the reference must direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures" in the reference. *Arkley*, at 587 (emphasis added). Because at least picking and choosing from the various disclosures in *Lee* would therefore be necessary, the anticipation rejection is improper for this reason.

Further to the Examiner's original reliance on inherency in the Office Action dated July 30, 2002, and Applicants previous response, the Examiner now argues that the product information brochure of Eastman AQ 55S from Eastman cannot be properly considered because it is not listed on an Information Disclosure Statement and does not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

provide evidence that the product is ethylene diglycol/cyclohexanedimethanol/isophthalates/sulphoisophthalates resin. Applicants respectfully disagree because Eastman AQ 55S is already disclosed in *Lee* as the aforementioned resin, and the submission of the Eastman AQ 55S product information brochure was merely to directly rebut the Examiner statements about this product in the previous Office Action.

Accordingly, Applicants respectfully request that the § 102(b) rejection be withdrawn.

B. Rejection under 35 U.S.C. § 103(a)

Turning to the rationale that allegedly supports the Examiner's § 103(a) rejection, the Examiner argues that the disclosure of *Lee* is directed to Eastman AQ polymers, which also consist of polymers with Tgs lower than 20°C. Applicants respectfully point out that although the current Eastman AQ products include a line of polyesters with Tgs lower than 20°C, the Examiner has not shown that such polymers were in existence at the time *Lee* was filed, i.e., December 17, 1992. Moreover, Applicants believe that such a showing is not possible because the Eastman AQ branched copolyesters referred to by the Examiner in the Final Office Action (page 4) were not known until after *Lee*'s filing date. Please see, for example, U.S. Patent No. 5,543,488, with an earliest effective filing date of at least December 29, 1993, and an article introducing Eastman AQ branched copolyesters published in December, 1995.

These documents provide evidence that the Eastman AQ branched copolyesters referred to by the Examiner were not known at the time *Lee* was filed, and would therefore not be considered part of *Lee*'s disclosure. The Eastman AQ polymers

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

disclosed in *Lee* do not include the claimed at least on tacky polymer having a Tg of less than 20°C, and nothing in *Lee* could suggest such a polymer. Additionally, the later available Eastman AQ polymers with Tgs lower than 20°C are branched copolyesters directed to be used as hot melt adhesive material, while the conventional Eastman AQ polymers exemplified in *Lee* are linear polyesters directed to be used in cosmetics.

Lee therefore has not and cannot provide any guidance to a person of ordinary skill in the art to select the later available Eastman AQ copolyesters with low Tgs from the disclosure of *Lee*. Such polymers were known only after *Lee* was filed, and, as set forth above, are structurally different from the Eastman AQ polymers disclosed in *Lee*. Accordingly, Applicants respectfully request that this § 103(a) rejection be withdrawn by the Examiner.

III. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 09, 2003

By: 

Mark D. Sweet
Reg. No. 41,469

Attachments

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com